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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/609,139	06/30/2000	Paul Lapstun		2319

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SILVERBROOK RESEARCH PTY LTD
393 DARLING STREET
BALMAIN, 2041
AUSTRALIA

EXAMINER

TAYLOR, APRIL ALICIA

ART UNIT PAPER NUMBER

2876

DATE MAILED: 03/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/609,139	Applicant(s) LAPSTUN ET AL.	
	Examiner April A. Taylor	Art Unit 2876	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>3/2/01</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Specification

1. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1, 2, 4-13, 15, and 16 are rejected under 35 U.S.C. 102(b) as being anticipated by Wellner (US 5,640,193).

Re claims 1, 2, 15, and 16: Wellner discloses a method of enabling a user to obtain, via coded data disposed on a surface, a document related to content of a video signal, the method including the steps of: receiving, from a sensing device, indicating data indicative of a request for the document, the sensing device, when placed in an

operative position relative to the surface, generating the indicating data using at least some of the coded data; extracting, from the video signal, document identity data indicative of an identity of the document; identifying, using the indicating data and the document identity data, the request and the document; retrieving the document; and displaying the document. (See col. 2, line 22 to col. 4, line 57)

Re claims 4 and 5: Wellner teaches wherein the video signal is derived from at least one video playback device; and wherein the playback device is one of a cassette-based video player and a disk-based video player (see col. 2, line 22 to col. 4, line 57).

Re claims 6 and 7: Wellner teaches wherein the video signal is derived from at least one video transmission; and wherein the video transmission is one of a broadcast television transmission, a cable television transmission, a satellite television transmission, and an Internet video transmission (see col. 2, line 22 to col. 4, line 57).

Re claim 8: Wellner teaches wherein the video signal has an analogue format (see col. 2, line 22 to col. 4, line 57).

Re claim 9: Wellner teaches wherein the video signal has a digital format (see col. 2, line 22 to col. 4, line 57).

Re claim 10: Wellner teaches wherein the coded data is indicative of an identity of a region of the surface and of a plurality of reference points of the region, and the indicating data is indicative of the identity of the region and a position of the sensing device relative to the region (see col. 2, line 22 to col. 4, line 57).

Re claims 11 and 12: Wellner teaches wherein the document identity data is extracted from at least one data channel of the video signal; and wherein the data

channel is one of; a caption data channel, a text data channel, and an extended data channel (see col. 2, line 22 to col. 4, line 57).

Re claim 13: Wellner further teaches the steps of receiving, from the sensing device, user identity data indicative of an identity of the user; identifying, using the user identity data, a user profile; and customizing, using the user profile, the document (see col. 2, line 22 to col. 4, line 57).

4. Claim 18 is rejected under 35 U.S.C. 102(e) as being anticipated by Knowles (US 6,068,188).

Knowles teaches a computer-based system having a printer including a receiver for receiving indicating data indicative of a request for the document; a decoder for extracting document identity data indicative of an identity of the document; a network interface; and a processor configured to transmit the indicating data and the document identity data, receive the document, and print the document (see col. 11, lines 19-67).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 3 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wellner (US 5,640,193) in view of Knowles (US 6,068,188). The teachings of Wellner have been discussed above.

Wellner fails to teach or fairly suggest the step of printing the document.

Knowles teaches a computer-based system having a printer for printing a document (see col. 11, lines 19-67). It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to employ the notoriously old and well known printer to the teachings of Wellner in order to physically provide additional information to the user.

7. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wellner (US 5,640,193). The teachings of Wellner have been discussed above.

Wellner fails to teach or fairly suggest wherein the coded data is invisible to the unaided human eye. It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to employ the notoriously old and well known invisible code, since applicant has not disclosed that using an invisible code solves any stated problem or is for any particular purpose and it appears that the invention would perform equally well with either feature. Thus, it would have been an obvious expedient to provide an invisible code, as it would have been a matter of design choice of the manufacturer.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Durst, Jr. et al. (US 2001/0011276) discloses a scanner enhanced remote control unit and system for automatically linking to on-line resources.

Knowles (US 6,321,991) discloses a web-based television set.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to April A. Taylor whose telephone number is (571) 272-2403. The examiner can normally be reached on Monday - Friday from 6:30AM - 4:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on (571) 272-2398. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [april.taylor@uspto.gov].

All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


April Taylor
23 February 2004



THIEN M. LE
PRIMARY EXAMINER